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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,525	06/28/2001	Manoel Tenorio	020431.0843	8191

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EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 12/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,525

Applicant(s)

TENORIO, MANOEL

Examiner

Susan Y Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☒ Claim(s) 1-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to amendment filed on 09/11/2003 (paper # 6).
2. Claims 1-37 are pending for examination, claims 1-37 have been amended.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 12 and 36, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman (Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, although claims 12 and 36 both recite an abstract idea at the preamble for associating target data with a product classification schema, however, the steps in the claim body merely applying a classification taxonomy schema to associate target data with a plurality of product attributes, which can be implemented by the mind of a person or by the use of a pencil and paper. In another words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deems to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 1, 12, 23 and 34-37, applicant fails to disclose the transition mechanism to transform a single product classification schema as stated in the preamble of these claims into the set of first schema and second schema as cited in the body of these claims, in addition, applicant did not define the metes and bounds of the claimed first schema and second schema. Furthermore, applicant also fails to disclose what mechanism was used to organize the claimed target data according to a second product classification schema. Thus, the instant application is not enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 2-11, 13-22 and 24-33, these claims have the same defect as their base claims, hence are rejected for the same reason.

5. Because of the enable issue of the amended claims, and per applicant's citation that "Applicant has made clarifying amendments to Claims 1-37. Certain of these

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amendments have not narrowed the claims, and none are considered necessary for patentability" [see the Remarks of Page 18, lines 5-8 of instant amendment filed on 09/11/2003] as such, the examiner regards that applicant has no intention to use instant amendment for applying a patent of his invention. Thus, based on the direction from applicant, the examiner maintains the same art rejection as filed in previous office action as following.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 12, 23, and 34, are rejected under 35 U.S.C. 102(b) as being anticipated by Chipman et al. (U.S. Patent No. 6,038,668).

As to claims 1, 12, 23, and 34, Chipman et al. (hereinafter referred as Chipman) discloses a computer-implemented system [e.g. Fig. 1, Fig. 5; Fig. 6] for associating target data with product classification schema with means, method and computer program product to perform the following processing:

- means [e.g. the High End Supplier with Page Generator (105), Fig. 1] for accessing the computer product classification schema [e.g. the Portal

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(102), Fig. 1], which comprising a taxonomy with hierarchical classes into which products is being categorized [e.g., col. 4, lines 9-17; 35- 40], the schema further comprising ontology associated with the classes, each ontology comprising one or more product attributes [e.g., col. 4, lines 16-21];

- means [e.g., the Low End Supplier with Browser only (104), Fig. 1] for accessing the target data to be associated with the schema [e.g. the Portal (102), Fig. 1];
- means [e.g. the Tool Suite (602), Fig. 6] for determining one or more classes with which at least a portion of the target data is associated based on a comparison between the target data and the product attributes of the ontology [col. 13, lines 43-60];
- means [e.g. the Local Portal (607), the Ontology Tracking Component (608), the Web Crawler (609), etc., Fig. 6] for associating at least a portion of the target data with one or more classes in response to determining one or more classes with which at least a portion of the target data should be associated [col. 11, line 61 - col. 12, line 44].

As to claims 2-6, 13-17 and 24-28, except all the features as discussed above, Chipman further discloses that the system associates a portion of the target data with the ontology of the classes by matching name, value, symbols and format [e.g. col. 4, lines 10-13; col. 6, lines 14-26].

As to claims 7-8, 18-19 and 29-30, except all the features as discussed , above, Chipman further discloses that the system uses vector space [e.g. the rank field mechanism, col. 8, lines 5-11; the table between lines 15 –24] and other statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attributes included in the ontology of the classes [e.g. the Tool Suite (602), Fig. 6; col. 13, line 39 – col. 14, line 4].

As to claims 10-11, 21-22 and 32-33, Chipman further discloses that the system associates a specific portion of target data with the classes by pointers [e.g. col. 2, lines 58 – col. 3, line 6; col. 3, lines 21-26].

As to claims 9, 20, 31, 35-37, Chipman discloses all the claimed features as discussed in claims 1-8, 10-11, 12-19, 21-30 and 32-33. Furthermore, he teaches that the product attributes, and values is stored in the seller (or supplier) databases [e.g., the Legacy Databases (406) of the supplier system, Fig. 4; col. 10, lines 26-38].

Response to Argument

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is (703) 308-1155. The examiner can normally be reached on 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-6296.

Susan Chen

December 24, 2003



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